

Application/ Control No.: 10/624,002
Examiner: GOLOBOY, James C

REMARKS

In paragraph 2 of the Office Action, claims 1,3, 7, 11-12 and 14-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over Kageyama in view of Wulfers.

Reconsideration is requested.

Claims 1, 14 and 15 have been amended to point out that the additive contains from 0.5 to 5 parts of a sodium sebacate. This amendment limits what may be in the base oil component. This amendment is supported by the specification, as filed, at page 9, line 8.

The Examiner has applied the Kageyama reference as teaching a grease comprising an alkydiphenylether oil and a diurea thickener having a structure meeting the limitations of claim 1. The Wulfers patent was applied as follows:

"[T]he sodium sebacate anticorrosion additive of Wulfers we and one of ordinary skill in the art would have a reasonable expectation of success in using it in the grease of Kageyama."

The data in the specification has been dismissed by the Examiner based on the concentrations tested. However, in the present case, the Examiner has deemed the prior art as imparting to a skilled worker in the art a reasonable expectation of success in using Wulfers sodium sebacate. Wulfers is silent as to any disclosure of a reasonable expectation of success in using the sodium sebacate in the manner that the Examiner has deemed to be obvious. In fact, Wulfers teaches away from combining the sodium sebacate with

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organic grease thickeners as they "do not afford the extended operating lifetimes as measured by thermal and mechanical stability at high temperatures" (col. 1, lines 53-56). Thus the negative teaching against the use of the organic thickeners, is persuasive that the combined teachings of Wulfers and Kageyamqa fail to establish a prima facie case of obviousness. The independent claims have been amended to recite a range of 0.5-5 parts by weight of sodium sebacate and the data of record is at 1 part by weight of sodium sebacate which is at the lower end of the claimed range.

Wulfers invention is related to a triazine urea compound that acts as a thickening agent and that compound is not an aromatic urea because the heterocyclic triazine ring is not an aromatic ring. In addition, the formula of claim 1 of Wulfers has an R group which is an aliphatic hydrocarbyl group of 16-22 carbon atoms. Since the triazine urea of Wulfers is distinctly different from the aromatic diurea of the present invention, the combination of the triazine urea compound and the sodium sebacate of Wulfers cannot suggest the combination of the aromatic diurea and sodium sebacate of the present invention and the unexpected results that have been disclosed in the present specification at pages 22 and 23. For this reason, the data of record which points out that grease compositions within the claims when used with a sealed bearing provide excellent results in the high-temperature and high-speed test, the sudden acceleration/deceleration test and the rust preventive test is persuasive of the non-obviousness of the claimed invention.

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Favorable consideration and early allowance are respectfully requested and earnestly solicited.

Respectfully submitted,


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